

**Notice of Allowability**

Application No.

10/531,495

Examiner

Yong Chu

Applicant(s)

BRESLIN ET AL.

Art Unit

1626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/16/2007.
2. ☒ The allowed claim(s) is/are 1-3, 6-9, 11 and 12 (renumbered as 1-9).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application                                |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date _____    | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance             |
|  | 9. <input type="checkbox"/> Other _____  |

## **DETAILED ACTION**

Claims 4-5, 10, and 13-38 have been canceled by the Amendment filed on 16 January 2007. Claims 1-3, 7, and 8 have been amended by the Amendment. Therefore, claims 1-3, 6-9, 11, and 12 are pending in this application.

### ***Response to Amendment***

The Amendments by Applicants' representative David Muthard dated on 16 January 2007 and 7 November 2006 have been entered.

### ***Response to Argument***

#### **Rejection under 35 U.S.C. §112 second paragraph**

The rejection over claim 4 under 35 U.S.C. §112 second paragraph is withdrawn after the claim was amended.

#### **Rejection under 35 U.S.C. §112 first paragraph**

The rejection over claims 1-3 and 6 under 35 U.S.C. §112 first paragraph is withdrawn after the claims were amended. The remained subject matters in claims 1-3 and 6 are enabled by the disclosure in the specification.

#### **Rejection over provisional double patenting**

Rejection over provisional double patenting over co-pending U.S. Patent application 10/559,857, 10/916,096, 10/567,676, 10/568,000, 10/915,743, 10/567,249, and 10/915,743. All the above co-pending applications have later effective filing date. According to MPEP§804, the instant application with earlier effective filing date should be allowed without requirement of filing Terminal Disclaimer or 37CFR1.130

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Declaration. During the telephonic interview with Attorney David Muthard dated on 16 January 2007, the Examiner reminded Applicants that Terminal Disclaimer and/or 37CFR1.130 Declaration may be needed to overcome the Double Patenting over the instant Application (see interview summary). Therefore, the rejection over provisional double patenting of co-pending U.S. Patent application 10/559,857, 10/916,096, 10/567,676, 10/568,000, 10/915,743, 10/567,249, and 10/915,743 is withdrawn.

**Claim objections**

The claim rejection over claim 8 is withdrawn after the claim was amended.

The claim rejection over claims 4,7, and 12 is withdrawn after the claims were cancelled or amended.

***Examiner's amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

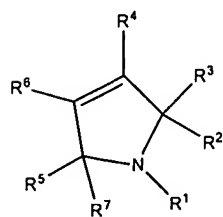
The application has been amended as follows:

In claim 1 page 4 line 26 of the amendment filed on -----, delete "heterocyclyl" after "said alkyl".

***Reasons for Allowance***

The present invention is directed to a compound of the formula (I)

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, wherein **a**, **b**, **r**, and **s** are 0 or 1; **m** is 0, 1 or 2; and **n** is 0;

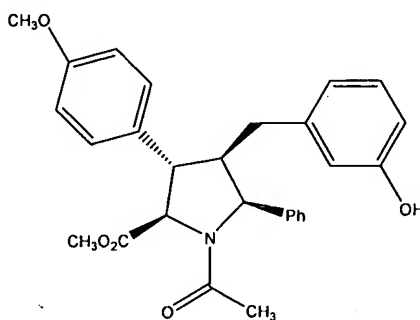
**R**<sup>1</sup> is (C<sub>1</sub>-C<sub>6</sub>-alkylene)<sub>n</sub>(C=O)C<sub>1</sub>-C<sub>10</sub>-alky or (C<sub>1</sub>-C<sub>6</sub>-alkylene)<sub>n</sub>(C=O)NR<sup>c</sup>R<sup>c'</sup>; said aryl is optionally substituted with one or more substituents selected from **R**<sup>10</sup>;

**R**<sup>2</sup> and **R**<sup>6</sup> are aryl; said aryl is optionally substituted with one or more substituents selected from **R**<sup>10</sup>;

**R**<sup>3</sup> is (C<sub>1</sub>-C<sub>6</sub>-alkylene)<sub>n</sub>(C=O)C<sub>1</sub>-C<sub>10</sub>-alky or (C<sub>1</sub>-C<sub>6</sub>-alkylene)<sub>n</sub>(C=O)NR<sup>c</sup>R<sup>c'</sup>, said aryl is optionally substituted with one or more substituents selected from **R**<sup>10</sup>;

**R**<sup>4</sup>, **R**<sup>5</sup> and **R**<sup>7</sup> are H or C<sub>1</sub>-C<sub>10</sub>-alky; said alkyl is optionally substituted with one or more substituents selected from **R**<sup>10</sup>; and the remaining substituents are defined in claim 1.

The closest prior art of record is WO98/08813 (S. Hollinshead). Hollinshead



disclose a compound of formula

The prior art compound is patentably distinct from the instantly claimed compounds with different core structures, wherein the core structure is pyrrolidinyl for the prior art compound, and is pyrroline for the instantly claimed compounds. The prior art application claims invention of a combinatorial library of pyrrolidinyl compounds with

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without related pharmaceutical applications. Therefore, claims 1-3, 6-9, 11, and 12 are allowed.

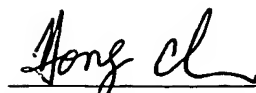
***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759.

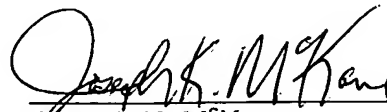
The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yong Chu, Ph.D.  
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Art Unit 1626



Joseph K. McKane  
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